

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANTHONY K. CAMPBELL, JAMES S. WOODHEAD and IAN WEEKS

Appeal No. 2006-0702
Application No. 08/455,414

HEARD: APRIL 25, 2006

Before PAK, OWENS and FRANKLIN, *Administrative Patent Judges*.
PAK, *Administrative Patent Judge*.

DECISION ON APPEAL

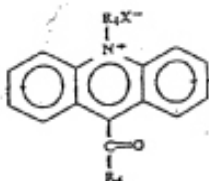
This is a decision on an appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 19 through 23 which are all of the claims pending in the above-identified application.

APPEALED SUBJECT MATTER

The subject matter on appeal is directed to a chemiluminescent labeling "compound [which] undergoes a light emitting reaction in the presence of a dilute aqueous solution of

sodium hydroxide and hydrogen peroxide " See the specification, page 2. This chemiluminescence compounds enables one of ordinary skill in the art to carry out "the analysis, assay, or location of proteins . . . [or] other substances of biological interest " See the specification, page 1. Details of this compound are recited in representative claim 19 which is reproduced below:

19. A chemiluminescent labeling compound for use in the labeling of a substance of biological interest, said compound being capable of undergoing a light emitting reaction in the presence of a dilute aqueous solution of sodium hydroxide and hydrogen peroxide and is defined by the formula:

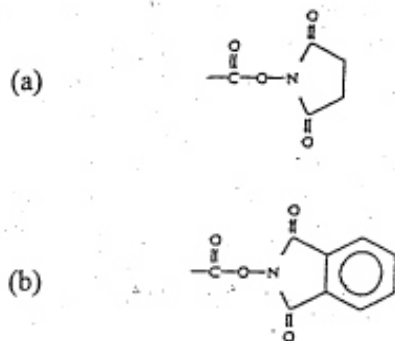


wherein the acridinium moiety is substituted, X⁻ is an anion,

R₁ is a substituent selected from the group consisting of hydrogen, alkyl, alkenyl, alkynyl and aryl, and

R₄ is substituted phenoxy moiety, with a reactive group capable of reacting with a substance of biological interest being attached, either directly or by means of an alkyl group, to the aryl portion of said phenoxy moiety, said reactive group being selected from the group consisting of:

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(c) -NCS

(d) $N^+H_2Y^-$
-C-OR₆

and wherein R₆ has the same definition as R₁, and Y is a halide, and

(e) -azide.

THE EVIDENCE

The appellants rely on the following reference evidence:

Sheehan et al. (Sheehan)	3,352,791	Nov. 14, 1967
Ullman	3,689,391	Sep. 5, 1972

THE REJECTIONS

The claims on appeal are rejected as follows:

I) Claims 19 through 23 under 35 U.S.C. § 112, second

paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicants regard as their invention; and

II) Claims 19 through 23 under 35 U.S.C. § 112, first paragraph, as lacking written descriptive support for the subject matter presently claimed.

OPINION

We have carefully reviewed the claims, specification and prior art, including all of the evidence and the arguments advanced by both the examiner and the appellants in support of their respective positions. This review has led us to conclude that the examiner's rejections are not well founded. Accordingly, we reverse the examiner's aforementioned rejections for essentially the reasons set forth in the Brief. We add the following primarily for emphasis and completeness.

35 U.S.C. § 112, Second Paragraph (Indefiniteness)

As the court stated in *In re Moore*, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971), the determination of whether the claims of an application satisfy the requirements of the second paragraph of Section 112 is

merely to determine whether the claims do, in fact, set out and circumscribe a particular area with a **reasonable** degree of precision and particularity. It

is here where the definiteness of language employed must be analyzed -- not in a vacuum, but always in light of the teachings of the prior art and of **the particular application disclosure** as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. [Emphasis ours; footnote omitted.]

The examiner has the initial burden of establishing that the claims on appeal do not adequately set out and circumscribe the scope of protection sought by the appellants with a reasonable degree of precision and particularity. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992) ("the examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability"). To carry this burden, the examiner criticizes the use of the phrase "wherein the acridinium moiety is substituted" in claim 19. See the Answer, page 7. Although the phrase in question is very broad in that it covers any and all substituted acridinium moieties capable of providing a light emitting property as recited in claim 19, its broadness cannot be equated with indefiniteness. *In re Gardner*, 427 F.2d 786, 788, 166 USPQ 138, 140 (CCPA 1970) ("[b]readth is not indefiniteness"). On this record, the examiner simply has not established that the broad phrase in question is indefinite.

Accordingly, we reverse the examiner's decision rejecting claims 19 through 23 under 35 U.S.C. § 112, second paragraph, as being indefinite.

35 U.S.C. § 112, First Paragraph (Written Description)

The written description requirement under the first paragraph of Section 112 is distinct from the enablement requirement of that Section. *See In re Alton*, 76 F.3d 1168, 1172, 37 USPQ2d 1578, 1581 (Fed. Cir. 1996). The written description requirement serves to ensure that the inventors had possession, as of the filing date of the application, of the specific subject matter later claimed. *In re Wertheim*, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976). The disclosure, as originally filed, need not literally describe the later claimed subject matter to establish possession of the later claimed subject matter. *Eiselstein v. Frank*, 52 F.3d 1035, 1038, 34 USPQ2d 1467, 1470 (Fed. Cir. 1995). It only needs to reasonably convey to a person having ordinary skill in the art that the inventors had possession of the subject matter later claimed at the time of the filing date of the application. *See Ralston Purina Co. v. Far-Mar-Co., Inc.*, 772 F.2d 1570, 1575, 227 USPQ 177, 179 (Fed. Cir. 1985).

Here, we concur with the appellants that implicit in the appellants' original disclosure at page 3 of the specification is that the inventors had possession of the claimed substituted acridinium moieties capable of providing a light emitting property to the claimed chemiluminescent labeling compound at the time of the filing date of the instant application. As correctly argued by the appellants (the Brief, pages 10-15), the declaration of record and literature evidence demonstrate that the determination of such substituted acridinium moieties was well within the ambit of one of ordinary skill in the art at the time of the invention. On this record, the examiner has not adequately explained why such original disclosure, together with the evidence proffered by the appellants, do not reasonably convey to one of ordinary skill in the art that the inventors had possession of the claimed substituted acridinium moieties. *Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444 ("the examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability").

Accordingly, we reverse the examiner's decision rejecting claims 19 through 23 under 35 U.S.C. § 112, first paragraph, as lacking written descriptive support for the subject matter presently claimed.

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CONCLUSION

In view of the foregoing, the decision of the examiner is reversed.

REVERSED

CHUNG K. PAK)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
TERRY J. OWENS)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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BEVERLY A. FRANKLIN)	
Administrative Patent Judge)	

CKP:hh

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